

Appl. No. 10/783,862  
Amendment/Response to Office Action

Docket No. 85804-015401

### REMARKS

The present application has been reviewed in light of the Office Action dated July 11, 2005. Claims 1 to 26 are the pending claims being examined in the application, of which Claims 1, 12 and 23 are the independent claims. Claims 1, 3, 7 and 9 are being amended herein.

Reconsideration and further examination are respectfully requested.

The claim amendments made herein are independent of the grounds for rejections raised in the Office Action. More particularly, while it is believed that the original wording of Claim 1 is sufficiently clear (in fact, the Office Action did not raise any objection/rejection as regards the wording), Claim 1 is amended to change "term" to read "criteria". Claims 3, 7 and 9 are amended in accordance with the amendment made to Claim 1. The amendments made herein are not believed to impact the scope or meaning of the claims, nor are the amendments believed to warrant a new search.

By the Office Action, Claims 1 to 23 are rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2003/0061211 (Shultz) and U.S. Publication No. 2002/0065671 (Goerz). As is described in more detail below, the rejection based on 35 U.S.C. § 103(a) is both factually and legally deficient. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Turning to the specific language of the claims, Claim 1 recites a system for providing an improved graphical user interface for web search. A search region contains a user's search criteria. A result region comprises indicia of a plurality of search categories. A connection indicator establishes a visual connection between the search region and a selected one of search category indicia so as to enable a user to make a cognitive connection indicating that the user's search criteria was found in the particular search category indicated by the connection indicator.

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The applied art, namely Shultz and Goetz, is not seen to teach or even to suggest the elements recited in Claim 1.

The Office Action concedes that Shultz fails to teach, disclose or suggest enabling a user to make a cognitive connection indicating that the user's search term was found in a particular search category indicated by a connection indicator. The Office Action relies on Goetz as showing this feature. However, as is discussed below, neither Goetz nor Shultz, either alone or in any permissible combination (if one even exists) disclose this feature, inter alia, of Claim 1.

Shultz describes a search engine which displays search results in a textual form, and displays a geographic map showing physical/geographic locations corresponding to the search results. The display of the search results provided by the search engine is shown in Figure 4 of Shultz. The display consists of a textual portion 440 that contains a textual listing of the search results (i.e., a listing of businesses) and a geographic reference portion 430 that displays a map of the geographic location of the results (i.e., the location of the businesses) listed in the textual portion 440. As described at paragraph 75 of Shultz, textual portion 440 shows the two search results identifying two music stores identified from a search using a user query specifying HMV music stores within a user defined area. The textual search results include icons 435 in the textual portion 440 which correspond to icons 445 in the mapping portion to provide an indication of the geographic location of the music stores listed in the textual search results. When one of the icons in either the textual portion 440 or the geographic reference portion 430 is selected, additional textual information is displayed in place of the displayed map or in a pop-up window. (See paragraphs 69 to 75 of Shultz)

The Office Action contends that paragraphs 66 and 70 of Shultz disclose a connection indicator establishing a visual connection between a search region and a selected one of search

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category indicia. However, paragraph 66 of Shultz simply describes a database of information that is searched to obtain the search results, as described above. More particularly and with reference to Figure 3, which is discussed in paragraph 66 of Shultz, the database includes fields of textual information that are searched to retrieve records based on the search criteria specified by the user. A database of textual information can not be said to be a connection indicator which establishes a visual connection between a search region and a selected one of search category indicia. Paragraph 70 of Shultz describes the ability for a user to specify a spatial search parameter to limit a search to a specified geographic area. More particularly, the user is able to specify a geographic area to limit a search using a mouse pointer within the geographic portion 430. However, this also is not the same as a connection indicator establishing a visual connection between a search region and a selected one of search category indicia.

The Office Action contends that paragraphs 73 to 79 disclose a result region comprising indicia of a plurality of search categories. At paragraph 73, Shultz indicates that the textual portion 440 enables a user to view information or categories of information associated with search results. However, the cited portion of Shultz fails to teach, suggest or disclose indicia of a plurality of search categories. In other words, the ability to view categories of information associated with search results is not the same as a result region having indicia of a plurality of search categories. In addition, nothing in the cited portions of Shultz teach, suggest or disclose a connection indicator which establishes a visual connection between a search region and a selected one of search category indicia of a result region.

In summary, as conceded in the Office Action, Shultz fails to teach, suggest or disclose enabling a user to make a cognitive connection indicating that the user's search term was found in a particular search category indicated by a connection indicator. Shultz also fails to teach,

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suggest or disclose a connection indicator which establishes a visual connection between a search region and a selected one of search category indicia of a result region. It therefore follows that Shultz fails to teach, suggest or disclose a connection indicator which establishes a visual connection between the search region and a selected one of search category indicia so as to enable a user to make a cognitive connection indicating that the user's search criteria was found in the particular search category indicated by the connection indicator.

Goetz has been reviewed and is not seen to remedy the above-noted deficiencies. More particularly, the Office Action relies on Figures 19C to 19U<sup>1</sup> ( Sheets 35 to 53, 19 sheets of drawings) and paragraph 100 of Goetz. Paragraph 100, which appears to be the only substantive discussion of Figures 19C to 19U, is reproduced in its entirety below:

"FIGS. 19A-W are screen shots highlighting the details of the service iwKnowledge, as included in an embodiment of the Website 8, where Website 8 is the Infrastructure World Website. FIGS. 19A-W illustrate the results of various navigated searches as navigated through different super categories and sub-categories in the indexed knowledge base 38."

The Office Action does not provide any specifics as to how Figures 19C to 19U teach the feature of Claim 1, i.e., the feature of enabling a user to make a cognitive connection indicating that the user's search criteria was found in the particular search category indicated by the connection indicator. Indeed, the only discussion in the Office Action of the specific application of Figure 19C of Goetz can be found in a discussion of Claims 2, 8 and 13. More particularly, at pages 3 and 4, the Office Action refers to Figure 19C of Goetz, and states, in relevant part:

"...see: Goetz Jr. et al, figure 19C, where the 'connection pointers' are pointing to the 'search region' [Select Region and Country] in the middle section of the page, and 'search category indicia' [Directory] on the left side of the page."

<sup>1</sup> Both the Office Action and the description in Goetz refer to a Figure 19W. However, there was no Figure 19W provided in the copy of Goetz provided with the Office Action. While the sheet numbering suggests that there is no Figure 19W, the Examiner is respectfully requested to provide clarification as to whether or not there is a Figure 19W, and to provide a copy if there is one.

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There is no discussion, in paragraph 100 of Goetz, of "connection pointers", let alone "connection pointers" pointing to a "search region" or "search category indicia", nor is there any description of a function, feature or structure which provides "connection pointers" or "connection pointers" pointing to a search region and search category indicia. Should the Examiner persist in his rejection on these grounds, it is respectfully requested that the Examiner specifically point out by drawing, reference number and paragraph citation the specific elements of Goetz that the Examiner equates to a connection indicator, a search region, a selected one of a plurality of search category indicia, and a visual connection between the search region and the selection search category indicia to make a cognitive connection indicating that the user's search criteria was found in the particular search category indicated by the connection indicator. See MPEP § 706.02(j)

Goetz describes providing pre-defined search criteria for searching an indexed knowledge base (i.e., indexed knowledge base 38, a multidimensional database), with an ability to sort the search results using pre-defined sorting criteria. Referring to paragraphs 41 and 42 of Goetz, the super categories and subcategories within a super category are predefined entry points into the indexed knowledge base 38. As described in paragraph 100 of Goetz, Figures 19A to 19U are results of navigated searches as navigated through different super categories and sub-categories in the indexed knowledge base 38.

However, nothing in the cited portions of Goetz is seen to teach, suggest or disclose a connection indicator which establishes a visual connection between a search region and a selected one of search category indicia. Finally, nothing in Goetz teaches, discloses or suggests a connection indicator establishing a visual connection between a search region and a selected one of search criteria indicia so as to enable a user to make a cognitive connection indicating that the

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user's search criteria was found in the particular search category indicated by the connection indicator.

In addition to the factual deficiencies of the 35 U.S.C. § 103(a) rejection noted above, the rejection is also seen to be legally deficient. At page 3, the Office Action states:

"[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Shultz et al by the teaching of Goetz Jr. et al because enabling a user to make [a] cognitive connection indicating that the user's search term was found in the particular search category indicated by the connection indicator, would enable the user to view both the search results and the selected search categories on the same page, making it easier for the user to refine the search criteria while viewing the matched results."

The Office Action fails to provide any support for the stated motivation to make the combination suggested in the Office Action. As the courts have clearly indicated, the Examiner must set forth with specificity where the motivation exists in the cited references, or, if the Examiner is relying on general knowledge of the art, that general knowledge must be capable of readily documented substantiation. See In re Lee, 277 F.3d 1338, 1343 and In re Zurko, 258 F.3d 1379, 1383-86. If the Examiner is relying on well-known facts or common knowledge in the art to provide the motivation, such facts and knowledge must be of a nature that are "capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03.A., citing In re Ahlert, 424 F.2d 1088, 1091 (CCPA 1970) (requiring that the notice of facts beyond the record which may be taken by the Examiner must be capable of instant and unquestionable demonstration so as to defy dispute).

In addition, the Examiner is required to place himself in the shoes of a person of ordinary skill in the art at the time the invention was made. See In re McLaughlin, 443 F.2d 1392 (CCPA 1971). It is this hindsight to which the McLaughlin case refers, which hindsight, in the context of McLaughlin, limits the Examiner only to that which was known to the person of ordinary skill at

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the pertinent time to which the rejection applies. As the Courts have amply set forth subsequent to McLaughlin, the Applicants' invention may not be used as the hindsight roadmap with which the Examiner winds his way through the prior art for identifying features and then, using the teachings of the claimed invention, "use that which the inventor has taught against its teacher" to provide the missing motivation to combine the references to yield the claimed invention. In re Lee, 277 F.3d 1338, 1344, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1993). As the Federal Circuit stated in In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999);

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See e.g., C.R. Bard, Inc. v. M3 Svs., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion "essential" to avoid hindsight)...Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. See e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.")

There is no showing of any support in the Office Action for the stated motivation to combine the Shultz and Goetz references. Without such a showing in the prior art, it can only be said that the disclosure of the present application is being used as a blueprint to piece together the Shultz and Goetz references to reject the claims of the present invention.

In this regard, the stated motivation mirrors the discussion of aspects and advantages of the claimed invention, as provided in the present Application. Reference is respectfully made to pages 3 and 4 of the present Application, wherein a discussion is found of the need for visually

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and reliably associating a search region having a search term with a category of result.

Reference is also respectfully made to page 8 of the present Application, which states in part:

"[t]y providing the visual connection indicator of the present invention at both the top and bottom of the page, the user need not navigate back to the top of the page to determine the category of search selected, and also which search category can be selected to further conduct or narrow the search."

In addition, reference is made to page 9 of the present Application, which states as follows:

"[t]he visual link between the search term 30 contained in the search field 20 and the search category 60 contained within selected tab 90 not only reduces the amount of textual data on the screen, but it also rapidly and intuitively draws the user's attention to the link between what was searched and the category of search from which the results obtained and currently displayed on the screen."

In view of the above, it is submitted that the Office Action uses Applicant's own disclosure to provide the otherwise missing motivation to combine the Shultz and Goetz references to yield the claimed invention, which is not permitted, as clearly stated by the courts in the case law discussed above. The Office Action fails to make a showing of a motivation to combine the Shultz and Goetz references, which showing is required to establish a prima facie case of obviousness under 35 U.S.C. § 103(a).

Based on the factual and legal deficiencies noted above, reconsideration and withdrawal of the 35 U.S.C. § 103(a) are respectfully requested. The applied art, namely Shultz and Goetz, either alone or in combination (n.b., such combination is not believed to be permissible at least in view of the lack of a showing of a motivation to combine, as discussed above) are not seen to teach, suggest or disclose each and every one of the features recited in Claim 1.

In view of the foregoing and for at least the reasons discussed above, Claim 1 is believed to be in condition for allowance. Claims 12 and 23 are also believed to be in condition for allowance for at least the same reasons.



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The other claims are each dependent from the independent claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In this regard, it is noted that Claim 7 is rejected on the same grounds as Claim 1 (see pages 2 and 3 of the Office Action). However, Claim 7 depends from Claim 1, and has the added features of alternate search region, alternate result region and alternate connection indicator, which are not even discussed in the grounds for rejection of Claim 7. Should the Examiner persist in his rejection of Claim 7 on these grounds, it is respectfully requested that the Examiner specifically point out by drawing, reference number and paragraph citation the specific elements of Goetz that the Examiner equates to an alternate search region, an alternate result region, and an alternate connection indicator establishing a visual connection between the alternate search region and the selected one of the alternate search category indicia. See MPEP § 706.02(j)

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

The Applicant respectfully requests that a timely Notice of Allowance therefore be issued in this case. Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

In this regard, Applicant's undersigned attorney may be reached by phone in California (Pacific Standard Time) at (714) 708-6500. All correspondence should continue to be directed to the below-listed address.

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The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

Respectfully submitted,

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